Attorney's Docket: 1999CH017D
Serial No.: 10/762982
Group: 1731

REMARKS

The Office Action mailed December 9, 2004, has been carefully considered together with each of the references cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been added. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

CLAIM STATUS

Claims 7, 8, 12 and 17-22 are pending in this Application. By this Amendment, claims 7, 8, 12 and 19 have been cancelled. Claims 17, 18, 20 and 22 have been amended while new claims 23-26 have been added to further clarify the subject matter which Applicants regard as the invention. Thus, the claims under consideration are believed to include claim 17, 18 and 20-26.

Information Disclosure Statement

The Office finds the Information Disclosure Statement, filed on September 15, 2004, failing to comply with 27 CFR § 1.98(a)(1). Attached herewith is a replacement Information Disclosure Statement containing a form 1449. Applicants respectfully request consideration of the information cited therein.

Claim Rejections Under 35 USC § 112

Claims 7 and 8 stand rejected under 35 USC § 112, second paragraph. Claims 7 and 8 have been cancelled by this Amendment.

The Office finds claims 7, 8 and 17-22 vague and indefinite "as the basis for the percentages is not recited, i.e., percentage with respect to what, the total weight of the formulation or to with respect to the combination of Ws and Fs, or with respect

to Ws." Claims 17 and 18 have been amended to recite that the percentage is based upon the aqueous solution (L_w).

In view of the forgoing, it is respectfully contended that the 35 USC § 112, second paragraph rejection have been overcome.

Claim Rejection Under 35 USC § 102/103

Claim 7, 8, 12 and 17-22 stand rejected under 35 USC § 102(b) as anticipated by or, in the alternative, under 35 USC § 103(a) as being obvious over Rohringer et al., US Patent No. 5,622,749. This rejection is respectfully overcome.

The Office states that Rohringer et al. teach a surface finishing agent containing a whitening fluorescent agent and a polyethylene glycol (PEG) component. The Office concludes that "Rohringer et al. seem to teach all the limitations of the claims or at least the minor modification to obtain the claimed invention would have been obvious to one with ordinary skill in the art.

Applicants respectfully can not agree with this conclusion. Concerning novelty, Rohringer et al. describe coating compositions and optical brightener dispersions or solutions. The aqueous dispersions of Rohringer et al. are disclosed in column 2, lines 40-45 as containing certain emulsifiers and/or dispersing agents. The solutions are disclosed in column 6, lines 25-34 as containing a glycol as a solvent together with the polyethylene glycol. Applicants' invention, as defined by independent claim 17, is a surface finishing agent in the form of an aqueous solution consisting of a surface-finishing active ingredient (W), water and optionally a non-finishing formulation additive (F). The surface finishing active ingredient (W) is defined as consisting of (W_1) polyethylene glycol with an average molecular weight of greater than 1500, (W_3) a wet strength additive and optionally at least one further additive selected from a finishing additive (W_2) which is at least one of a dye and an optical brightener, and a formulation additive (W_4) which is at least one agent for pH adjustment. (F) is selected from (F_{11}) antifoams and (F_{12}) agents for protecting against the damaging effect of micro-organisms. None of (W_2), (W_3), (W_4), (F_{11}) and

(F_{12}) is an emulsifier or dispersant or a solvent. There is nothing in Rohringer et al. suggesting that a surface finishing agent can be made in the absence of an emulsifier or dispersant. Further, Applicants' surface finishing agent is made without an organic solvent such as a glycol. Moreover, there is no teaching, or disclosure within Rohringer et al. suggesting the introduction of a wet strength additive. For at least these reasons, it is respectfully contended that Rohringer et al. does not anticipate Applicants' invention as defined by claims 17, 18 and 20-22.

Regarding obviousness, it is respectfully contended that the Office has not carried its burden of providing a *prima facie* case of obviousness. Given the fact that Applicants' surface-finishing active ingredient (W) is defined using the transitional phrase "consisting of," there is no teaching within Rohringer et al. that its composition could be formed in the absence of the emulsifier, dispersant or organic solvent and still arrive at a superior surface finishing agent. In contrast, one with ordinary skill in the art, having a knowledge of Rohringer et al., would be disinclined to alter such reference to eliminate those constituents, for to do so would require the artisan to abandon the teachings of Rohringer et al.

Furthermore, there is nothing within Rohringer et al. that discloses, teaches or suggests the introduction of a wet strength additive (W_3) as defined by amended independent claim 17.

A *prima facie* case of obviousness requires the prior art to provide motivation for one with ordinary skill in the art to alter the reference in a manner necessary to arrive at an applicant's claimed invention. In consequence, it is respectfully submitted that Rohringer et al. can not provide such motivation as the composition advanced by Rohringer et al. require additional constituents not forming a part of Applicants' invention, while providing no teaching of a wet strength additive. For at least these reasons, it is respectfully contended that Rohringer et al. does not render claims 17, 18 and 20-22 obvious.

Claims 7, 8, 12 and 17-22 stand rejected under 35 USC § 102(b) as being anticipated by or, in the alternative, under 35 USC § 103(a) as obvious over Moren, US Patent No. 3,661,633. This rejection is respectfully overcome

Moren relates to the impregnation of wood with polyols in the presence of thermoplastic resins or resin forming materials and does not disclose, teach, or suggest a wet strength additive (W_3). The reason for Moren's failure to disclose a wet strength additive becomes apparent when it is considered that wood is a hard, rigid material. No wet strength problem arises in the processing of wood and, therefore, no ordinary artisan would consider its addition. In consequence, as Moren does not disclose, teach, or suggest a wet strength additive (W_3), Applicants' invention, as defined by claim 17, 18 and 20-22 can not be anticipated thereby.

With respect to obviousness, one with ordinary skill in the art having a knowledge of Moren would find no reason to alter the reference to include a wet strength additive. Again, the reason for this is apparent, as Moren is speaking to the issue of wood impregnation. No wet strength additive would be needed. Moren, therefore, can not provide the motivation required under § 103 and, thus, fails to make Applicants' invention obvious.

Claims 7, 8, 12, 17, 18 and 21 stand rejected under 35 USC § 102(b) as being anticipated by Ploetz et al., US Patent No. 3,779,791. This rejection is respectfully overcome.

Ploetz et al. disclose a polyethylene glycol solution to impregnate paper. As defined by independent claim 17, as amended, Applicants' surface finishing agent includes a wet strength additive (W_3). Nowhere in Ploetz et al. is a wet strength additive disclosed or suggested. As a result, Ploetz et al. can not anticipate independent claim 17, nor any claims depending there from. For at least this reason, it is respectfully contended that claims 17, 18 and 21 are not anticipated by Ploetz et al.

Attorney's Docket: 1999CH017D
Serial No.: 10/762982
Group: 1731

In view of the forgoing, it is Applicants' courteous position that the 35 USC § 102 and § 103 rejections have been overcome. Applicants, therefore, request reconsideration and withdrawal of the rejections.

As the total number of claims does not exceed the number of claims originally paid for, no fee is believed due. However if an additional fee is required, the Commissioner is hereby authorized to credit any overpayment or charge any fee deficiency to Deposit Account No. 03-2060.

In view of the forgoing amendments and remarks, the present application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,

Anthony A. Bisulca
Attorney for Applicant
Registration No. 40,913

(CUSTOMER NUMBER 25,255)

Clariant Corporation
Industrial Property Department
4000 Monroe Road
Charlotte, North Carolina 28205
Phone: (704) 331-7151
Fax: (704) 331-7707